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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,008	07/09/2001	Yoshiyuki Shino	35.C15536	4382

5514 7590 11/02/2004

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NEW YORK, NY 10112

EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,008

Applicant(s)

SHINO ET AL.

Examiner

Tamra L. Dicus

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1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08-05-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16, 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-16, and 18-22 stands rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,841,134 to Hida et al. in view of USPN 5,254,525 to Nakajima et al., and further in view of USPN 5,786,055 to Sei et al. for reasons of record as previously set forth in the Office Action mailed 05/05/04.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Applicant's arguments filed 08-05-04 have been fully considered but they are not persuasive. Applicant argues none of the cited references teaches or suggests the barrier layer as claimed in the present invention. Applicant's allege the purpose of the barrier layer as instantly claimed is to prevent ink that remains on an image-recording portion from coming into contact with the circuit part. Applicant further alleges when the concentration of ionic chlorine in the barrier layer material is 100 ppm or less, corrosion of the circuit part is unlikely to occur. Applicant has not persuasively argued because Nakajima, Hida, and Sei teach a barrier functionality applied to adhesives. Applicant argues Hida is not seen to (1) teach providing an

ink-receiving layer or (2) recognize the adverse effects of ink on IC modules. Hida teaches an IC card. The IC card includes in this order: an IC (4)/adhesive (6)/reinforcing member (5)/oversheet (2b). The reference of Nakajima provides the following structure in this order: a support, an adhesive (equivalent barrier material functionality), image-receiving layer with an ink sheet/layer over to form the image (ink receiving). The IC memory is on the support. See col. 1, lines 35-45, col. 6, lines 1-23, col. 7, lines 1-15, col. 10, lines 15-60. The Examiner did not use Hida to teach the structure including an ink-receiving layer, Nakajima was used to teach this layer as previously set forth. Hida is still used to teach the inclusion of a barrier between the IC and support. See Figures 1a-1d and Figures 6 and 7. Applicant argues Nakajima does not teach the concept of using a barrier layer between an ink-receiving layer and a circuit. However, the combination of Hida and Nakajima teach this concept as previously set forth. Hida teaches all the essential elements minus the ink-receiving layer, which Nakajima teaches in a laminate with an IC part, and teaches the inclusion of an ink-receiving layer for the purpose of providing an image to the laminate. Hida et al. discloses providing an IC card with a reinforcing sheet to provide mechanical strength and flexibility to the card, and suggests that printing may be carried out on the back of the substrate of the IC card. The Applicant has not provided objective evidence to teach the barrier as provided by the prior art could not in fact function as Applicant alleges-to prevent ink from coming into contact with the circuitry. The same barrier thickness range is also taught by Nakajima, therefore ink would not reach the IC part, just as Applicant desires. Applicant argues that Sei teaches it is required to completely remove chloride ion from an adhesive for semiconductors. If chloride ion is completely removed, then it would meet the claim limitation to the chloride ion being 100 ppm or less. As previously set forth, "or less"

means the inclusion of zero, which means the chloride ion need not be present as Applicant has acknowledged that Sei teaches. Moreover, because both Hida and Nakajima do not mention chloride ion in the adhesive barrier, then the ion is not present. Applicant further argues that Sei does not mention corrosion of a circuit part caused by contact with ink. This language is not in any claim. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant also argues the purpose of the instant invention is different from the prior art. The argument is not persuasive because the same requirements are taught by the combination, the reasoning need not be the same. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The rejection of claims 14-16 and 18-22 are maintained for reasons of record.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

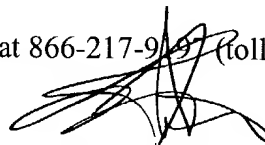
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

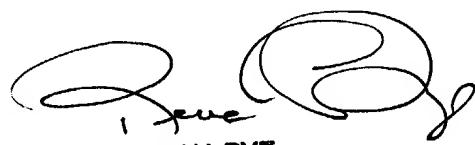
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

10/26/04



RENA DYE
SUPERVISORY PATENT EXAMINER 10/30/04
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